

Response under 37 C. F.R. § 1.116

Attorney Docket No. 550718-093

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REMARKS/ARGUMENTS

Claims 1-17 are currently pending in the application. Reconsideration of the application is respectfully requested.

Claims 1-17 stand finally rejected as being unpatentable over U.S. Patent No. 6,183,158 to Lynton in view of U.S. Patent No. 6,045,161 to Ashcraft et al. This rejection is respectfully traversed for the following reasons.

According to the Office action, Lynton discloses a binder insert comprising a transparent plastic bag-shaped body with an open upper side, a plurality of store portions which can store photographs, memos, etc. and a binding section having holes. The Office acknowledges that Lynton fails to disclose a store board comprising thick paper folded in two and having slits at a predetermined location, color paper between facing surfaces of the thick paper, slits in various shapes and slits to hold photographs on an outside surface of the thick paper. The Office action relies on Ashcraft et al. for teaching a store board comprising thick paper folded in two with a set of slits at a predetermined location and color paper disposed between the thick paper surfaces. According to the Office action, it would have been obvious to modify Lynton's binder insert to include a store board comprising folded paper having slits and color paper disposed therein for the purpose of "mounting indicied substrate(s) in a stable position between the folded store board, so as to prevent movement of the substrate(s)." Office action, page 3-4.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the claims of the pending application because the documents cited by the examiner, considered either individually or in combination, fail to disclose each and every element of the claim structure. Furthermore, the proposed motivation for modifying the references or combining the references fails to satisfy the requirement for a clear and particular motivation to combine the references. In the previous response, applicants argued that no such motivation to combine the references exists. **The final Office action failed to address this argument, the substance of which is repeated below.**

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The documents cited by the examiner fail to disclose or suggest a binder insert containing a memo store portion and a photograph store portion as set forth in the claims of the pending application. The Office relies on the broad statement in Lynton that the flexible sheet protector may comprise two or more receiving pockets and the broad description of “contents” to include prints, paper, paperboard, etc. to arrive at the conclusion that Lynton discloses a binder sheet comprising a memo store portion and a photograph store portion. However, applicants respectfully submit that the broad disclosure is insufficient to indicate why one of skill in the art would pick and choose from all of the disclosed possibilities for the contents and use of a plurality of pockets to arrive at a binder sheet containing a photograph store portion and a memo store portion as set forth in the claims of the pending application.

Furthermore, the Office fails to provide any motivation for this modification of the Lynton protective cover to obtain the applicant’s construction. It is insufficient to simply identify broad disclosures in the cited document and indicate that the protective cover could be modified to include two pockets, one of which is for photographs and the other which is for memos. Accordingly, the cited documents fail to disclose or suggest a memo store portion and a memo inserted therein as presently set forth in claim 1 or a memo store portion as set forth in claim 17.

Furthermore, the cited references fail to disclose or suggest a “store portion and a memo store portion provided by dividing said body at a melting point” as set forth in claims 1 and 17. The Examiner contends that various processes can be used to make the store portions and patentability is based solely on the product. Applicants respectfully submit that the Examiner’s construction of this phrase is incorrect. As set forth in MPEP §2113, “[t]he structure implied by the process steps should be considered . . . where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” See, e.g., *In re Garnero*, 412 F.2d 276, 279 (CCPA 1979). In the present application the process set forth for providing the store portions should be considered. Neither reference discloses the described process and therefore, the claims cannot be considered obvious over the cited references.

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Therefore, for at least these reasons, applicants respectfully submit that the documents fail to disclose these elements of the pending claims and therefore the obviousness rejection must fail as a matter of law.

The Office action further indicates that Ashcraft discloses a color paper (34) disposed between the thick paper surfaces of a store board 36. Applicants respectfully submit that Ashcraft fails to disclose either of these elements of the present invention. Element 36 of Ashcraft is a support sheet which includes tabs 44 for supporting display sheet 38. However, external frame 42 although integrally formed with the support sheet 36 is a frame and not a store board. There is no way of storing a photograph or other item on the frame 42.

Likewise, element 34 in Ashcraft is the tab assembly including the support sheet 36, display sheet 38, internal frame 40 and external frame 42. Tabs 44 are provided on the support sheet 36. As shown in Fig. 4 of Ashcraft et al., both the display sheet 38 and the internal frame 40 are held by tabs 44 and the external frame 42 covers them so as to form the tab assembly 34 (shown in Fig. 5). Therefore, the external frame 42 holds the display sheet 38 and they are inserted into the front cover pocket 28 thereafter. The Examiner contends that the tabs 44 could be folded to the outer side of the support sheet 36 to hold a sheet. However, in this configuration the display sheet could not be held in conjunction with the internal frame and external frame which are required in Ashcraft to secure the display sheet 38 because, by design, these components are positioned to secure the display sheet against the support sheet. Bending the tabs outwardly, as suggested by the examiner, would defeat the purpose of the Ashcraft assembly because the display sheet would not be secure and it would not be positioned such that it could be viewed on the binder cover. The teachings of the reference fail to render the claims of the pending application *prima facie* obvious because the proposed modification would change the principle operation of the prior art. MPEP 2143.01. The principle operation of the Ashcraft et al. reference is to provide a method for presenting display sheets on a cover of a binder wherein the display sheet is held in a fixed position relative to a support sheet 36 using internal frame 40, external frame 42 and tabs 44. These components all work together to secure the display sheet.

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Turning the tabs 44 to the outside would destroy the functionality of the Ashcraft et al. assembly. The support sheet 36 can only support the display sheet on one side, not on both sides. Therefore, for at least this reason as well, Applicants respectfully submit that the claims of the pending application are not obvious over the cited references of record.

Applicants also maintain that the cited references fail to provide the requisite motivation to combine and modify the cited prior art references.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. See, e.g., *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d (BNA) 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching may come from the prior art, the knowledge of one skilled in the art or from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994,999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the Applicants' application. *In re Paulsen*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994) ("Multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.").

The Office action indicates that it would have been obvious to combine the teachings of Lynton with that of Ashcraft to teach the invention as claimed. The proposed motivation for combining the references is to provide a method of mounting the substrate in a stable position. Applicants respectfully submit that the necessary motivation to combine these references is not present. The motivation to combine must be "clear and particular" and in the present case the purported motivation is neither.

Specifically, one of ordinary skill in the art at the time of the present invention would not have been motivated to combine Lynton with Ashcraft to teach the invention as claimed because the references fail to provide any motivation to make the proposed combination. Furthermore,

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applicants submit that the two references are not properly combinable. One of skill in the art reading the Lynton reference would not be motivated to combine Lynton with Ashcraft's method for supporting a display sheet in a stable position.

Lynton is directed to a protective cover for sheets disposed within a looseleaf binder or scrapbook. Ashcraft et al., by contrast, describes a display sheet on the front cover of a binder. Although both documents relate to binders in general, the specific uses are entirely different and one of skill in the art would not look to one to modify the other. Accordingly, applicants respectfully submit that the documents cited fail to supply the requisite motivation to combine and modify the teachings to arrive at the present invention.

To establish a *prima facie* case of obviousness there must be some motivation or suggestion in the references that would lead one of ordinary skill in the art to combine the various components, without knowledge of the claimed invention, to obtain the present invention. *In re Kotzab*, 217 F. 3d 1365, 1371, 55 U.S.P. Q. 2d (BNA) 1313, 137 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with knowledge of the claimed invention, would have selected these components for combination in the manner claimed"). The mere identification of the various components in the prior art references is insufficient to render the present invention obvious. The motivation or suggestion "must be considered in the context of the teaching of the entire reference." *Id.* The references cited are devoid of any suggestion of picking and choosing various features of each reference to arrive at the present invention. One of skill in the art could never arrive at the present invention based on any motivation or suggestion in the references without the benefit of the applicants' disclosure. Accordingly, applicants submit that the claims of the present application are not obvious over the combined teachings of the cited references.

Applicants further submit that claim 17 is patentable over the cited references for additional reasons. Claim 17 recites a store board having first and second portions wherein the first and second portions include slits at predetermined locations thereof to insert corners of a photograph on an outside surface of the thick paper. **The examiner has not cited any art or**

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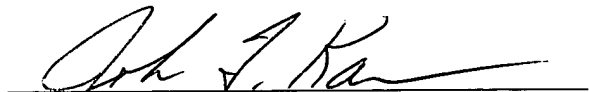
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indicated any motivation for modifying the references to show this feature of claim 17.

Ashcraft, even according to the Examiner's interpretation, fails to disclose two portions of the store board **each of which includes slits** for holding photographs. Although the support sheet 36 does have tabs 44, the other portion of the "store board" is the external frame 42 which does not have any tabs or slits. Furthermore, there would be no reason for modifying the external frame 42 to include tabs because the external frame is simply used to secure the display sheet in the tab assembly. Accordingly, applicants submit that claim 17 is patentable for at least this reason and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

In light of the foregoing response, it is respectfully submitted that claims 1-17, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested. If the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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